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21 AUG 2003

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In re Application of
MAXWELL et al.
Application No.: 10/031,723
PCT No.: PCT/GB00/02812
Int. Filing Date: 20 July 2000
Priority Date: 20 July 1999
Attorney Docket No.: 31574-00007
For: A SWITCH

DECISION ON PETITION

UNDER 37 CFR 1.137(a)

or in the Alternative,

UNDER 37 CFR 1.137(b)

This is a decision on applicant's petition under 37 CFR 1.137(a) or 1.137(b) filed in the United States Patent and Trademark Office (USPTO) on 29 April 2003.

## BACKGROUND

On 20 July 2000, applicant filed international application no. PCT/GB00/02812 which claimed a priority date of 20 July 1999, and which designated the United States.

On 20 February 2001, a Demand was filed with the International Preliminary Examining Authority electing the United States. As a result the deadline for entry into the national stage in the U.S. expired 30 months from the priority date, 20 January 2002.

On 18 January 2002, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: the basic national fee.

On 16 April 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration in compliance with 37 CFR 1.497 identifying the application by the International application number and international filing date along with a $65 surcharge for filing the oath or declaration after the 30 month period was required.

On 17 October 2002, applicant filed a request for a five month extension of time, without a proper reply, that is, an executed oath or declaration in compliance with 37 CFR 1.497, as indicated in Form PCT/DO/EO/905.

On 25 November 2002, a Notification of Abandonment was mailed to applicant indicating that the application was abandoned for failure to respond to the Notification of Missing Requirements.

On 29 April 2003, applicant filed the present petition requesting that the application be revived under 37 CFR 1.137(a) on the grounds that the entire delay was unavoidable. In the alternative, applicant requests revival under 37 CFR 1.137(b) indicating that the abandonment was unintentional.

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## DISCUSSION

### PETITION TO REVIVE UNDER 37 CFR 1.137(a)

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay requires (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable; and (4) a terminal disclaimer pursuant to 37 CFR 1.137(c).

The requisite petition fee of $55 has been paid satisfying Item (2) above. With regard to Item (1), applicant has submitted the required reply with the submission of an executed declaration, in compliance with 37 CFR 1.497, and the $65 surcharge for filing the declaration after the thirty month period. As for Item (4), the terminal disclaimer is not required in this application since it was filed after 08 June 1995.

However, regarding item (3), applicant has not provided an acceptable showing that the delay was unavoidable. Applicant states that they are a foreign entity and unaware of the U.S. filing requirements and that "despite reasonable efforts", applicants could not obtain the executed declaration from inventor Warren until February 10, 2003 and "then could not in good faith submit the declaration until they have resolved the questions of inventorship." This showing is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). The delay resulting from a failure in communication between applicant and his attorney does not constitute unavoidable delay within the meaning of 37 CFR 1.137(a). In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988)

A petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 U.S.C. 133. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987). Therefore, since applicant has not satisfied item (3) above, the granting of the petition under 37 CFR 1.137(a) for revival based on unavoidable delay would not be proper.

### PETITION TO REVIVE UNDER 37 CFR 1.137(b)

As an alternative, applicant requests revival of the application via petition under 37 CFR 1.137(b).

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the date on which the application became abandoned. Such a petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply; (2) the petition fee required by law, and (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional", and (4) by a terminal disclaimer and fee in all applications filed before 08 June 1995 pursuant to 37 CFR 1.137(c).

As discussed above, the proper reply was the submission of the executed declaration in compliance with 37 CFR 1.497 and no terminal disclaimer is required because the application was filed after 08 June 1995. As for Item (2), the petition fee required by law is $650 for a small entity and per their authorization, will be charged to applicant's deposit account.

Applicant's statement, "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" complies with 37 CFR 1.137(b).

Having fulfilled the requirements for revival under 37 CFR 1.137(b), the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

## CONCLUSION

For the reasons above, the petition to revive under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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